UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/645,821	08/20/2003	Jamey Graham	015358-006520US	7875

20350   7590   01/23/2008
TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

EXAMINER
THERIAULT, STEVEN B

ART UNIT	PAPER NUMBER
2179	

MAIL DATE	DELIVERY MODE
01/23/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

Office Action Summary	Application No.	Applicant(s)
	10/645,821	GRAHAM ET AL.
	Examiner	Art Unit	
	Steven B. Theriault	2179	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 September 2007*.

2a)☐ This action is **FINAL**.　　　　2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-69* is/are pending in the application.

　　4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-69* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

　　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

　　Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

　　a)☐ All　b)☐ Some * c)☐ None of:

　　　1.☐ Certified copies of the priority documents have been received.

　　　2.☐ Certified copies of the priority documents have been received in Application No. _____.

　　　3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

　　* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
　　Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
　　Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1.   This action is responsive to the following communications: Amendment filed 09/12/2007.

2.   Claims 1-69 are pending in the case.

Claim Rejections - 35 USC § 101

3.   35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 47-69 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The language of the claims raise a question as to whether the claims are directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101.

With regard to **claims 47-69,** claims 47-69 recite a computer program product that does not appear to provide a tangible result. The claims do not appear to recite a practical application of the abstract idea, law of nature, or natural phenomenon. A claimed invention is directed to a practical application of a 35 U.S.C. 101 judicial exception when it:

(A)   "transforms" an article or physical object to a different state or thing; or

(B)   otherwise produces a useful, concrete and tangible result,

The steps recite a product that are intended calculations that are to be performed within the processor that do not recite a real world tangible result because the steps do not recite a transformation to a different state or thing that is usable and tangible. The present application specification does not specifically recite a computer program product and the Examiner cannot refer to the definition to determine the scope and bounds of the product, which would also be objected to under MPEP 608.01 (o). The specification does define software modules that are executed by a processor as follows:

[0078] Storage subsystem 306 may be configured to store the basic programming and

data constructs that provide the functionality of the computer system and of the present invention. For example, according to an embodiment of the present invention, software modules implementing the functionality of the present invention may be stored in storage subsystem 306 of MIPSS 104. For example, software modules that facilitate generation of printable representations of the multimedia information may be stored in storage subsystem 306 of MIPSS 104. These software modules may be executed by processor(s) 302 of MIPSS 104. In a distributed environment, the software modules may be stored on a plurality of computer systems and executed by processors of the plurality of computer systems. Storage subsystem 306 may also provide a repository for storing various databases and files that may be used by the present invention. For example, the multimedia documents may be stored in storage subsystem 306. Storage subsystem 306 may comprise memory subsystem 308 and file storage subsystem 310.

Therefore, the product claims can be interpreted as including at least one alternative embodiment where the end result of the product is software, per the specification definition. Additionally, the claims do not provide a structure to execute the code and transform the product into a real world tangible result. The claims recite code for performing a step but do not recite a step for converting the code to a result. Further, it appears the product, while stored on a medium, does not recite the feature of including a medium to classify the claims into the article of manufacture. Therefore, the examiners interpretation of the product as recited is not consistent with MPEP 2106 [r-5] and the claimed subject matter does not include the medium to execute the product to make the result intertwined with the medium and the claims also do not recite a structure or step to produce a result.

To expedite a complete examination of the instant application the claims rejected under 35 U.S.C 101 (nonstatutory) above are further rejected as set forth below in anticipation of applicant amending these claims to place them within the four statutory categories of invention.

Claim Rejections - 35 USC § 103

4.   **The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:**

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459

(1966), that are applied for establishing a background for determining obviousness under

35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness
    or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims

under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various

claims was commonly owned at the time any inventions covered therein were made

absent any evidence to the contrary. Applicant is advised of the obligation under 37

CFR 1.56 to point out the inventor and invention dates of each claim that was not

commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g)

prior art under 35 U.S.C. 103(a).

5. **Claims 1-3, 10-13,16,18-26, 33-36, 39, 41-49, 56-59, 62, 64-69 are rejected under 35**

    U.S.C. 103(a) as being anticipated by Rajasekaran et al. (hereinafter Rajasekaran)

    U.S. Publication No. 20030024975 filed Nov. 15, 2001, in further view of Kauffman et

    al. (hereinafter Kauffman) U.S. Patent No. 7280738 file Apr. 9, 2001.

In regard to **Independent claim 1,** Rajasekaran teaches a computer-implement method
of accessing a portion of recorded information using a paper document, the method
comprising:

- Receiving information indicative of selection of one or more identifiers from a

  first set of identifiers printed on the paper document (See Para 0067 and 79).

  Rajasekaran teaches selecting object identifiers from physical objects (See also

  Table 1, page 10).

- Determining one or more time ranges based upon the one or more identifiers, each time range having a start time and an end time (See Para 62). Rajasekaran teaches reading a timestamp that can have a temporal event that occurs periodically or randomly. Rajasekaran teaches the timestamp can be read to facilitate the display of content related to the timestamp. Therefore, a timestamp can have a beginning or end time. For example, Rajasekaran teaches a user interface that allows a user to view a catalog with an index. The index can be searched by scanning for an ID on a label. Therefore, images can be stored in a folder or index based on timestamps and scanning an index for a picture with a beginning and end time can be performed (See Para 0090 and 0095 -96). The timestamp label is read in from a paper medium via a barcode (See Para 0099).

Rajasekaran does not expressly teach:

- Determining portions of the recorded information corresponding to the one or more time ranges, wherein a portion of recorded information corresponding to a time range comprises information from the recorded information occurring between the start time and end time associated with the time range.

Kauffman teaches a process of corresponding one or more time codes where the recorded information occurs between a start time and an end time (See column 5, lines 24-50 and column 10, lines 50-67 and column 11, lines 1-5). Kauffman teaches the frame can be selected by detecting its time code that can be input by an OCR tool or a watermark, which are examples of processes that read from a physical document and convert to a digital format. Kauffman and Rajasekaran are both systems that allow the user to select an item that contain a machine readable code that instructs the computer to perform a function.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention, having the teachings of Rajasekaran and Kauffman in front of them,

to modify the timestamps of Kauffman to include a process to computer timestamps to determine a range between the timestamp labels. Kauffman suggests the combination through the teachings of allowing or providing a system that segments video in an archive to allow a user to access the content and select items for review during the compilation of a storyboard to other video production processes (See column 1, lines 40-52). Further, Kauffman teaches the direct process of accessing a code from a medium where the code is read via an OCR or watermark reader, which can comprise codes that describe content or location of content.

With respect to **dependent claim 2,** Rajasekaran teach the method wherein one or more time ranges includes a first time range and determining portions of the recorded information comprises determining at least one of information of the first type and information of the second type from the recorded information occurring between the start time and end time associated with the first time range. (See Para 0051-52).Rajasekaran teaches a method wherein the recorded information comprises information of a first type and information of a second type and teaches that an index of content items is organized by timestamp (See Para 0090). Rajasekaran teaches scanning an index to look for objects (See Para 0096-0098) and the objects are identified by reading a barcode off of paper (See Para 0099).

With respect to **dependent claim 3,** Rajasekaran teaches the method wherein the information of the first type is video information and the information of the second type is at least one of audio information and closed-caption text information (See Para 0074, media content can be in one or more formats).

With respect to **dependent claim 10,** Rajasekaran teaches the method wherein the identifiers in the first set of identifiers are barcodes (See Para 0021), and receiving information indicative of selection of the one or more identifiers from the first set of

identifiers comprises reading at least one barcode from the paper document using a barcode reader (See Para 0044).

With respect to **dependent claim 11,** Rajasekaran teaches the method further comprising receiving information indicative of selection of one or more identifiers from a second set of identifiers printed on the paper document (See Para 0038, 42 and 65) determining one or more operations based upon the one or more identifiers selected from the second set of identifiers; and performing at least one operation from the one or more operations on a portion of the recorded information corresponding to at least one time range from the one or more time ranges (See Para 0079-81).

With respect to **dependent claim 12,** Rajasekaran teaches the method wherein performing the at least one operation comprises outputting the portion of the recorded information corresponding to the at least one time range from the one or more time ranges (See Para 0063 and 74 and 95-96).

With respect to **dependent claim 13,** Rajasekaran teaches the method wherein performing the at least one operation comprises communicating the portion of the recorded information corresponding to the at least one time range to a recipient (See Para 39).

With respect to **dependent claim 16,** Rajasekaran teaches the method wherein performing the at least one operation comprises deleting the portion of the recorded information corresponding to the at least one time range from the recorded information (See Para 54). Deleting a portion of the tree that represents a tour can be performed by reading a barcode that expressly instructs to delete the operation on the tour.

With respect to **dependent claim 18,** Rajasekaran teaches the method wherein

performing the at least one operation comprises storing the portion of the recorded

information corresponding to the at least one time range (See Para 73-74).

With respect to **dependent claim 19,** Rajasekaran teaches the method further

comprising receiving information indicative of selection of one or more identifiers from a

second set of identifiers printed on the paper document (See Para 0038, 42 and 65) and

determining one or more operations based upon the one or more identifiers from the

second set of identifiers and performing at least one operation from the one or more

operations on portions of the recorded information corresponding to the one or more time

ranges(See Para 0079-81)..

With respect to **dependent claim 20,** Rajasekaran teaches the wherein performing the at

least one operation comprises ranking the one or more time ranges based upon contents

of the portions of the recorded information corresponding to the one or more time ranges

(See Para 0095and 0075).

With respect to **dependent claim 21,** Rajasekaran teaches the wherein ranking the one

or more time ranges comprises for each time range in the one or more time ranges,

determining relevance of the portion of the recorded information corresponding to the

time range to a user-specified criterion (See Para 0075) and ranking the one or more

time ranges based upon the relevance of the portions of the recorded information

corresponding to the time ranges to the user-specified criterion (See Para 0095-0099).

With respect to **dependent claim 22,** Rajasekaran teaches the wherein the user-

specified criterion identifies a topic of interest (See Para 0090). A timestamp in an index

associated with a child's learning process stored on a video and linked by an annotation.

With respect to **dependent claim 23,** Rajasekaran teaches the method wherein performing the at least one operation comprises grouping the one or more time ranges into one or more groups based upon contents of the portions of the recorded information corresponding to the one or more time ranges (See Para 0096-0099 and 73-75).

Claims **24-26, 33-36, 39, 41-46** reflect the system comprising computer readable instruction for performing the method steps of 1-3, 10-13, 16, 18-23, respectively, and are rejected along the same rationale.

Claims **47-49, 56-59, 62, 64-69** reflect the computer program product comprising computer readable instruction for performing the method steps of 1-3, 10-13, 16, 18-23 respectively, and are rejected along the same rationale.

7.   **Claims 14, 15, 17, 37-38, 40, 60-61, and 63 are rejected under 35 U.S.C. 103(a) as being anticipated by Rajasekaran et al. (hereinafter Rajasekaran) U.S. Publication No. 20030024975 filed Nov. 15, 2001, in view of Wilz et al. (Hereinafter Wilz) U.S. Patent No. 6152369 filed Aug. 4, 1997.**

With respect to **dependent claims 14 and 15,** Rajasekaran in view of Kauffman teach every limitation of claim 13.
Rajasekaran in view of Kauffman does not expressly teach the method wherein communicating the portion of the recorded information corresponding to the at least one time range to the recipient comprises communicating the portion of the recorded information via an electronic mail addressed to the recipient or via facsimile. However, these limitations would have been obvious to one of ordinary skill in the art at the time of

the invention, having the teachings of Rajasekaran, Kauffman and Wilz in front of them, to modify the system of Rajasekaran to send the information in the database to another person via email. Rajasekaran suggests that the information can be sent as an email attachment (See Para 0084) and Wilz teaches a file that can be sent via email and facsimile to another user where the item is printed and then faxed (See column 24, lines 26-67 and column 25, lines 1-21). Rajasekaran and Wilz teach using paper mediums to store bar codes that can be scanned by a user. The bar codes represent information that can be retrieved. Both inventions teach the bar codes comprise information directing the user to media content and both have codes that include time values. The motivation to combine Wilz with Rajasekaran comes from the suggestion in Wilz that the use of bar codes can simplify the entry of commands to direct the computer to perform a process such as entering a URL or directing the machine to send an email containing the information of interest (See column 2, lines 30-50 and 59-67 and column 3, lines 5-15). Moreover, Wilz teaches accessing presentations from a barcode and Rajasekaran teaches the creation of tour that is a presentation, which is an expressed example in the art of using the teachings of Rajasekaran.

With respect to **dependent claim 17,** Rajasekaran in view of Kauffman teach every element of claim 11.
Rajasekaran in view of Kauffman does not expressly teach the method wherein performing the at least one operation comprises printing a representation of the portion of the recorded information corresponding to the at least one time range on a paper medium to generate a second paper document. However, these limitations would have been obvious to one of ordinary skill in the art at the time of the invention, having the teachings of Rajasekaran, Kauffman and Wilz in front of them, to modify the system of Rajasekaran to modify the system of Rajasekaran to perform an operation to print the representation of the information with the teachings of Wilz that allows for barcode menus printed on

paper to be selected by users scanning through a catalog or collection of information. The codes are selected by the user that include a point in time or over a period in time to determine which items should be within the menu under composition. Wilz further teaches that the arranged information can be in a number of columns or pages to encompass the information. Theses two teachings suggest that a set of items from a catalog occurring at a point in time can be selected and arranged in a menu to be printed by the system that can be on one or more pages of paper. (See column 18, lines 44-67 and column 23, lines 20-67 and column 24, lines 1-25).

Claims **37-38 and 40** reflect the system comprising computer readable instruction for performing the method steps of 14-15 and 17, respectively, and are rejected along the same rationale.

Claims **60-61 and 63** reflect the computer program product comprising computer readable instruction for performing the method steps of 14-15 and 17, respectively, and are rejected along the same rationale.

6.   **Claims 4-9, 27-32, 50-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rajasekaran in view of Kauffman as applied to claims 1-3 above, and further in view of Jun et al. (hereinafter Jun) U.S. Patent No. 6931594 filed Nov. 2, 2000.**

With respect to **dependent claims 4-9,** as indicated in the above discussion, Rajasekaran in view of Kauffman teaches all of claim 1.

Rajasekaran teaches the method wherein the one or more identifiers selected from the first set of identifiers comprise a first and second identifier (See Para 0067 and 79). Rajasekaran teaches that the user can select labels in any sequence they desire (before or after) (See Para 0078) as the sequence is as the user browsed through the content. Rajasekaran also teaches scanning an index after reading in a barcode for material printed on a label. The timestamp of on label can be compared to another timestamp during the tour (See Para 0090 and 0096-0099) to determine the sequence in which the information is presented to the user. Rajasekaran teaches that one or more labels can be assigned to an object identifier (See Para 0074) where images and video and audio can be linked to the same object ID. Certainly, audio and video are different types of recorded information. Rajasekaran does not expressly teach *determining the portions of the recorded information corresponding to the one or more time ranges comprises determining a portion of the recorded information occurring between the first time and second time associated with the first identifier and wherein the start time of the first time range is determined by subtracting a first amount of time from the time associated with the first identifier and an end time of the first time range is determined by adding a second amount of time to the time associated with the first identifier and wherein the first amount of time and the second amount of time are user-configurable.* Kauffman teaches a process of selecting a video frame by scanning a barcode from a paper medium and detecting its time code. Kauffman teaches the frame number is determined from the video and another corresponding frame and time code are retrieved, which is an example of determining a time range from a time code. Kauffman teaches it can determine time codes corresponding to any frame number by computing a "delta" offset when reading comparing MPEG1 (slow streams) to MPEG2 (fast streams), Which can suggest a process of adding times to one frame and subtracting from another but does not suggest that the times are user configurable. The interpretation by the Examiner comes from the

understanding that the present application allows a user to read **a time value** from a paper object that is representative of time ranges (See figure 24, present application). The server system would then determine the ranges from the codes and retrieve the information as shown in (figure 24, present application). Therefore, Rajasekaran clearly teaches reading barcodes from paper where the codes include timestamps and an index of content can be organized by timestamp. Kauffman teaches scanning a barcode to retrieve a given frame from a barcode and teaches a process of calculating a range from the time code. Rajasekaran in view of Kauffman do not teach the user *wherein the first amount of time and the second amount of time are user-configurable.* However these limitations would have been obvious to one of ordinary skill in the art at the time of the invention, in view of Jun, because Jun teaches a user configurable slider that can show a start and end frame based on a range selected by the user. The frames are selected based on a time code. Rajasekaran teaches the storing and accessing streaming media (See Para 110) and Kauffman teaches reading time codes from streaming media stored in MPEG formats and Jun teaches having a user interface to specify the time ranges to look at in the streaming media. The motivation to combine Jun with Rajasekaran and Kauffman comes from the suggestion in Jun that to generate an index, similar to Rajasekaran of indexed timestamps of content, a user interface allowing the user to designate a position and time range is necessary (See column 1, lines 25-32).

Claims **27-32**, reflect the system comprising computer readable instruction for performing the method steps of 4-9, respectively, and are rejected along the same rationale.

Claims **50-55**, reflect the computer program product comprising computer readable instruction for performing the method steps of 4-9, respectively, and are rejected along the same rationale.

Response to Arguments

Applicant's arguments with respect to claims 1-69 have been considered but are moot in view of the new ground(s) of rejection.

It is noted that any citation to specific pages, columns, lines, or figures in the prior art references and any interpretation of the references should not be considered to be limiting in any way. A reference is relevant for all it contains and may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art. In re *Heck*, 699 F.2d 1331, 1332-33,216 USPQ 1038, 1039 (Fed. Cir. 1983) (quoting In re *Lemelson*, 397 F.2d 1006,1009, 158 USPQ 275, 277 (CCPA 1968)).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 5682540 to Klotz, that teaches a paper based medium where machine readable code convey information to the user about the information on the page by accessing a computer with the information embedded in the code. The information can be user specific information based on keywords or information recognized from the accessed images.

U.S. Patent No. 5938727 to Ikeda, which also teaches a paper based interface that contains codes that are read by a scanner and direct a user to access the media on a computer.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven B. Theriault whose telephone number is (571) 272-5867. The examiner can normally be reached on M, W, F 10:00AM - 8:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo can be reached on (571) 272-4847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Steven B Theriault/
Patent Examiner
Art Unit 2179